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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,458	10/16/2000	Philip A. Lodwick	MGI-179	1632

7590 09/20/2004
Barry R Lipsitz
Law Offices of Barry R Lipsitz
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Building 8
Monroe, CT 06468

EXAMINER

NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/688,458

Applicant(s)

LODWICK, PHILIP A.

Examiner

Dustin Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date see below.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1 – 8 are presented for examination.

Information Disclosure Statement

2. Please resubmit missing Foreign Patent Document from IDSs for consideration.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

No Oath/Declaration is identified with the application at time of examination.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-88 of U.S. Patent No. 6,748,471 [hereinafter as '471 patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming common subject matter as follow:

Taking claim 1 as an exemplary claim, the '471 patent contains the subject matter claimed in the instant application. As per claim 1, both applications are claiming common subject matter, as follows:

A method for communicating a print job over a network, comprising:

providing a print driver ...;

operably associating ...; and

enabling said print driver ...;

said spooling server ...; and

said spooling server

The claims of '471 patent do not specifically disclose a print driver as described in the claim 1 of instant application but it would have been obvious to a person skill in the art to recognize that the two set of claims are similar because firmware or software as disclosed in '471 patent would have and perform the same functionality as driver as disclosed in the instant application.

As per independent claims 2, 4, 5, 6, 8 , they are also directed to the same subject matter recited in claim 1 above. Accordingly, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

As per dependent claims 3 and 7, they are depending on rejected claims, they are provisionally rejected under the judicially created doctrine of obviousness-type double patenting.

6. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-90 of copending Application No. 09/688475 [hereinafter '475 application] and claims 1-108 of copending Application No. 09/688457 [hereinafter '457 application]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons as disclosed above for claims 1-8.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 3 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following terms lack antecedent basis:

I. A method - claims 3 and 7, line 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motegi [US Patent No 6,307,640] in view of Adamske et al. [US Patent No 6,615,234].

11. As per claim 1, Motegi discloses the invention substantially as claimed including a method for communicating a print job over a network, comprising:

providing a print driver [i.e. program] [col 3, lines 1-14];

said client device capable of generating a printable document and providing print requests to the print driver [i.e. image document] [Abstract; and col 3, lines 19-25]; and

enabling said print driver to forward the print job to a spooling server via the network [

113, Figure 1; and col 2, line 57-60]; wherein:

said spooling server is capable of receiving and storing said print job from the print driver

via the network [Figure 3; Abstract; and col 1, lines 60-65]; and

said spooling server is capable of forwarding the print job to a printer in response to a polling request for said print job [col 3, lines 33-37 and lines 44-46].

Motegi does not specifically disclose

operably associating the print driver with a client device.

Adamske discloses

operably associating the print driver with a client device [col 6, lines 34-42].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Motegi and Adamske because Adamske's teaching would allow client to control multiple printing devices to add the portability aspect to the system.

12. As per claim 2, it is rejected for similar reasons as stated above in claim 1. Furthermore, Motegi does not specifically disclose said print driver forwards said print job to said spooling server as web-style traffic. Adamske discloses said print driver forwards said print job to said spooling server as web-style traffic [Figure 3; and col 4, lines 61-col 5, lines 14]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Motegi and Adamske because Adamske's teaching of web-style traffic would allow to control the system from different location in a more efficient manner.

13. As per claim 3, Adamske discloses

the print server is located within a gateway firewall [28, Figure 2];

the spooling server is located outside of said gateway firewall [30, Figure 2]; and

the print driver forwards the print job to the spooling server such that reconfiguration of the gateway firewall is not required [col 3, lines 64-col 4, lines 8].

14. As per claim 4, it is rejected for similar reasons as stated above in claim 1. Furthermore, Motegi discloses providing a personal identification number (PIN) with each print job forwarded to the spooling server; and storing one or more print jobs at the spooling server according to the PIN [i.e. job number] [Figure 2; Abstract; and col 1, lines 62-65].

15. As per claims 5-8, they are rejected for similar reasons as stated above in claims 1-4. Furthermore, Motegi discloses an interface for receiving a print job from a client device and a transmitter [i.e. interface units] [Figure 2; and col 3, lines 1-14].

16. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on flex.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached at (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen

Examiner

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 JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Continuation of PTO-1449: 01/19/2001; 04/22/2002; 08/21/2002; 09/30/2002; 01/14/2003; 02/24/2003; 07/30/2003;
08/20/2003; 09/22/2003; 02/11/2004; 02/26/2004; 07/26/2004.